Remarks

Claims 1 through 15 are pending in this application. In the office action of August 30, 2005, Examiner rejected independent claim 1 under 35 U.S.C. §102(b) as being anticipated by Fallier, Jr. et al. (US Pat. 4,328,446). hereinafter "Fallier". Examiner also rejected claims 2-4 and 9-11 under 35 U.S.C. §103(a) as being unpatenable over Fallier in view of Jurek (US Pat. 5,945,786). Finally, Examiner rejected claims 1-4 and 9-11 under 35 U.S.C. §103(a) as being unpatenable over Murayama (US Pat. 4,587,460) in view of Yoshido et al. (US Pat 6,563,268). Examiner indicated that claims 5-8 and 12-15 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim..

I. REJECTIONS UNDER 35 USC 102(b)

INDEPENDENT CLAIM 1

Independent claim 1 is directed towards a starter assembly for a gas discharge lamp comprising at least one switch located in the gas discharge lamp, and a control unit operable for actuating the switch, wherein the control unit actuates the switch for a predetermined length of time.

Fallier discloses an apparatus for starting a high intensity gas discharge lamp and comprising a switch (28, 60) and an igniter (16). In the above-referenced office action, the examiner stated that the igniter (16) is operable for actuating the switch (28, 60) for a predetermined length of time. Applicants respectfully disagree with the examiner's interpretation of Fallier. Contrary to the examiner's assertions, igniter (16) is not operable for actuating a switch (28, 60). In fact, Fallier states "The igniter 16, also well known in the art, **is operative to provide high amplitude, short duration pulses** which assist in initiating discharge in the discharge lamp 10." (col. 2, line 68 – col. 3, line 3) (emphasis added). Clearly, the igniter (16) of Fallier does not actuate the switch (28, 60). In addition, Fallier fails to suggest, teach, or disclose a starter assembly comprising at least one switch located in a gas discharge lamp. Therefore, at least because Fallier fails to teach or disclose a control unit operable for actuating a switch for a predetermined length of time, and at least because Fallier fails to suggest, teach, or

disclose a starter assembly comprising at least one switch located in a gas discharge lamp, applicants respectfully request the rejection of this claim be withdrawn.

II. REJECTIONS UNDER 35 USC 103(a)

DEPENDENT CLAIMS 2-4 AND 9-11

Claims 2-4 and 9-11 were rejected as being unpatentable over Fallier in view of Jurek. Jurek discloses a lamp igniter which "comprises a converter circuit which can superimpose an instantaneous high voltage on top of the ballast voltage." (col. 5, lines 9-11). Jurek fails to suggest, disclose, or teach either a control unit operable for actuating a switch or a starter assembly comprising at least one switch located in a gas discharge lamp. As discussed above, Fallier fails to suggest, disclose, or teach either a control unit operable for actuating a switch or a starter assembly comprising at least one switch located in a gas discharge lamp. Therefore, both Fallier and Jurek, individually or in combination, fail to disclose each element of the claimed invention. Accordingly, applicants respectfully request the rejection of these claims to be withdrawn.

INDEPENDENT CLAIMS 1 AND 9

Independent claims 1 and 9 were also rejected as being unpatenable over Murayama in view of Yoshida. In the office action, Examiner states "Murayama discloses a starter/igniting circuit for a gas discharge lamp..." Applicants respectfully disagree with the examiner's interpretation of Murayama. Contrary to the examiner's assertion, Murayama does not disclose a starter/igniting circuit. Instead, Murayama discloses a discharge lamp operating circuit designed to control the discharge of an already ignited gas discharge lamp. Murayama states "the present invention teaches a circuit configuration of the high-pressure discharge lamp operating circuit which is so designed that an A.C. discharge of a frequency not higher than 1 KHz, for example, may mainly take place at least within a predetermined period ***following the initiation of ignition of the arc*** tube, and D.C. or high-frequency discharge is allowed to take place only after the electrode arc spots have been transferred to the respective electrode tips." (col. 3, lines 4-12, emphasis added). In particular, Murayama discloses a lamp operating circuit in which a high voltage, low-frequency discharge is established between the lamp electrodes for 10-60 seconds,

after which timer (3) operates relay (4) to change over the low-frequency power source to (2) to the main power source (1). (column 3, lines 46-53).

In the office action, examiner also states "Yoshida discloses a starting circuit for a gas discharge lamp (Fig. 2) comprising a switch (19) resides within the gas discharge lamp (Fig. 1)." Switch (19) of Yoshida is defined as a thermally-actuated switch which is opened by the heat generated by resistor (18) or from arc tube (2).

First, with regards to the combination of Yoshida and Murayama, the references fail to disclose, teach or suggest the subject matter of the claims. In particular, the references cited fail to disclose a starting circuit for a gas discharge lamp comprising at least one switch located in the gas discharge lamp, and a control unit operable for actuating the switch, wherein the control unit actuates the switch for a predetermined length of time. The references also fail to disclose a starter assembly for a gas discharge lamp comprising a magnetic switch located in the gas discharge lamp, an electronics module operable to actuate the magnetic switch, the electronics module further comprising an electromagnet, a control unit operable to control the operation of the electromagnet, wherein the electronics module actuates the magnetic switch for a pre-determined length of time.

Second, even if the references did disclose or teach each of the elements of claim 1, applicants respectfully submit that the requisite identification of a teaching or suggestion anywhere in the art to modify Murayama and Yoshida has not been fulfilled. Examiner stated that the combination of the references would have been obvious to one of ordinary skill at the time of the invention. This position, however, is contrary to well-established patent law, which has specifically rejected the proposition that combinations, *per se*, of known elements render a claim obvious. "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries of the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Instead of allowing hindsight reconstruction of the claimed invention from the prior art, an inducement in the form of "some teaching, suggestion, or motivation to combine the

references" is required. *Id.* at 1456. More specifically, the examiner must show reasons why one of skill in the art, confronted with the same problems that the inventor faced and with no knowledge of the claimed invention, would select the elements from the prior art for combination as recited in the claims. *Id.* at 1458. Indeed, it is not even clear how one skilled in the art would combine a thermally-actuated switch with a lamp operating circuit, and arrive at the invention claimed in the present application.

DEPENDENT CLAIMS 2-4 AND 8-11

Dependent claims 2-4 and 8-11 were also rejected as being unpatentable over Murayama in view of Yoshida. Applicants respectfully submit that these claims should be allowed for the same reasons set forth above for independent claims 1 and 9.

Conclusions

Applicants thank Examiner Vo for the comments and suggestions made in the above referenced Office Action. Applicants respectfully request reconsideration of the above-identified patent application. In view of the above arguments, the Applicants believe that the pending claims are in condition for allowance. If, for any reason, the Examiner feels that the above amendments and remarks does not put the claim in condition for allowance, please contact the undersigned attorney to resolve any remaining issues.

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Respectfully submitted,

By _____

Marc T. Filigenzi
Registration No. 46,700
Attorney for Applicant
ALTICOR INC.
7575 Fulton Street East
Ada, Michigan 49355-0001
(616) 787-7303